



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,671	08/25/2003	Larry D. Powell	18236.133	3206

21878 7590 11/26/2004

KENNEDY COVINGTON LOBDELL & HICKMAN, LLP
214 N. TRYON STREET
HEARST TOWER, 47TH FLOOR
CHARLOTTE, NC 28202

EXAMINER

SAKRAN, VICTOR N

ART UNIT	PAPER NUMBER
----------	--------------

3677

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,671

Applicant(s)

POWELL ET AL.

Examiner

VICTOR N SAKRAN

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election with traverse of Group I, filed September 2004, is hereby acknowledged. The traverse on the ground that the method claims in Group II, are related in bundling of sinuous wires by a clip and the search for the article of Group I, would include a search for the method claims. Such argument is not found persuasive.

Applicant's attention is directed to Group II, wherein the limitations of Group II, by claiming the method steps for aligning the loops in the bundle of sinuous wires, pulling the base portion of the clip over the other side of the sinuous wires, flattened the legs of the clip before positioning its hooks over one side of the sinuous wires, heating the sinuous wires in an oven to increase the curve in the legs of the clip and the sinuous wires are stacked on a pallet in group eight to ten clamped bundles for shipping, wherein such step limitations as recited in the method claims of Group II, are not required in order for the article claims of Group I.

Therefore, Group II, is different invention with different classification, and different searches which are required for examination purposes.

Moreover, Applicant's argument with respect to the restriction requirement does not comply with the requirement of 37 CFR 111(b), M.P.E.P. 818.03(a). Under this rule, the Applicant is required to specifically point out the reasons on which he or

Art Unit: 3677

she bases his or her conclusion that a requirement to restriction is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR 1.111.

The restriction requirement is still deemed proper and is hereby made FINAL.

An action on the elected claims 1-9, of Group I, is as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones U. S. Patent No. 6,128,882 (cited by Applicant) in view of Ackermann U. S. Patent No. 2,986,787.

Jones discloses Applicant's claimed clip device having a generally U-shaped configuration with an open end and a closed end for receiving an article into said clip, wherein said closed end defining a base portion including a leg extending from each end of said base defining the open end of said clip and the end portion of each leg is provided with a hook bend inwardly toward the base portion of said clip for securing the article into the clip, see Figure 3(a); the abstract, and column 5, lines 50-56, except that the reference to Jones is silent about the particular use of its clip device for clamping a plurality of sinuous wires. Ackermann teaches the use of a clip (5) adapted for clamping a plurality of sinuous wires (1,2); see Figures 1,4; column 1, lines 63-72, and claim 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the clip device in Jones for clamping a plurality of sinuous wires in the manner taught, disclosed and suggested by Ackermann, especially, since the particular use of the clip device for clamping a plurality of sinuous wires or the like is considered to be no more than a matter of design choice obvious to one having ordinary skill in the art.

Furthermore, the term "for" as recited in the claim 1, and also in claim 9, perform a function and is not a positive limitation but only requires the ability to so perform

and it does not constitute a limitation in any patentable sense; see In Re Hutchison, 69 USPQ 138.

Moreover, it has been held that a recitation with respect to the manner in which a claimed device is intended to be employed does not differentiate the claimed device from a prior art apparatus satisfying the claimed structural limitation ; see Ex parte Masham, 2 USPQ 2d 1647 1987.

Claims 5,6,8 and 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claims 1-4, above, and further in view of Wantland U. S. Patent No. 3,234,616 who teaches the use of a clip device having a base portion (12) which is indented inwardly in the direction of legs (13,14). Note that the hooks (20) formed at each end of the legs extend in differing planes; see Figures 1,2,6; column 2, lines 62-71, and claim 1, and to further incorporate such modification in the clip device in Jones by merely indented its base portion inwardly in the direction of its legs in order to perform the desired function by preventing the clip from disengaging prematurely from the article in the manner taught, disclosed and suggested by Wantland, it would have been obvious to one having ordinary skill in the art at the time the invention was made, especially, since such modification involves only routine skill in the art.

Furthermore, Applicant is reminded that in considering the disclosure of these references, it is proper to take into account not only specific teaching of these

Art Unit: 3677

references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom; see *In re Preda*, 401 F2d 825, 826, 159 USPQ 342,344 (CCPA1968).

Claims 10-15, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 8, 2004.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the prior art cited herein, and of record, as showing structure related to Applicant's disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR N SAKRAN whose telephone number is 703-308-2224. The examiner can normally be reached on 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. swann can be reached on 703-308-4115. The fax

Art Unit: 3677

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 16, 2004



VICTOR N SAKRAN
Primary Examiner
Art Unit 3677